

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

<p>Application No.: 10/688,338</p> <p>Applicant: Shintani</p> <p>Filed: October 17, 2003</p> <p>Title: APPARATUS AND METHOD FOR USE IN TELEVISION CHANNEL MAPPING</p> <p>Examiner: John Manning</p> <p>Art Unit: 2614</p> <p>Customer No.: 37123</p> <p>Confirm. No.: 2276</p>	<p><u>Certificate of Transmission/Mailing</u></p> <p>I hereby certify that this correspondence is being facsimile transmitted to the USPTO, or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the date shown below:</p> <p>_____ Steven M. Freeland Registration No. 42,555 Attorney for Applicant</p>
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AMENDMENT C

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Responsive to the Office Action mailed December 30, 2005 and the Advisory Action mailed April 5, 2006, Applicant provides the following:

REMARKS

Responsive to the Office Action mailed December 30, 2005 and the Advisory Action mailed April 5, 2006, Applicant provides the following. Twenty (20) claims remain pending in the application: Claims 1-20. Reconsideration of claims 1-20 in view of the remarks below is respectfully requested.

Initially, Applicant acknowledges with appreciation the Examiner's willingness to take part in the telephonic interview on April 28, 2006.

By way of this response, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the Examiner telephone the undersigned at (858) 552-1311 so that such issues may be resolved as expeditiously as possible.

Summary of Applicant Initiated Examiner Interview

1. Per 37 CFR § 133(b), the following is a brief summary of the Examiner interview conducted April 28, 2006 via telephone between Steven M. Freeland, Attorney of Record, and Examiners John Manning and Scott Beliveau. Again, Applicant acknowledges with appreciation Examiner Manning's and Beliveau's willingness to take part in the telephonic interview.

The Declaration pursuant to 37 C.F.R. § 1.131 filed February 28, 2006 (referred to below as the February 131 Declaration), the advisory action mailed April 5, 2006 and the demonstration of diligence provided in the February 131 Declaration were discussed. Applicant's representative demonstrated that there was only a two month time period between the effective date of the cited reference and the filing of the subject application arguing that outside counsel is provided a reasonable time to prepare and file the application and that the February 131 Declaration factually demonstrated diligence.

No specific claims or prior art were discussed, no exhibits were shown or any demonstrations conducted, and no agreement was reached.

Claim Rejections - 35 U.S.C. § 102

1. Claims 1-3, 7-10, 17-18 and 20 stand rejected under 35 U.S.C. § 102(e), as being anticipated by U.S. Patent Application Publication No. 2004/0036811 (Ikeguchi).

Attached herewith is a revised Declaration from the Applicant, Peter Rae Shintani, pursuant to 37 C.F.R. 1.131 (referred to below as the 131 Declaration) and a Declaration from Steven M. Freeland, attorney of record (referred to below as the Freeland Declaration). The 131 Declaration and accompanying Exhibits A-G factually demonstrate that the invention was conceived in the United States of America, a NAFTA and WTO member country, prior to the August 18, 2003 effective date of the Ikeguchi reference, that Applicant diligently prepared an Invention Disclosure form that was forwarded by the Assignee to outside counsel prior to the effective date of the Ikeguchi reference, that the subject application was prepared and filed shortly thereafter, and that the Applicant was diligent in helping complete the application for filing. Therefore, the 131 Declaration factually demonstrates diligence at least from just prior to the August 18, 2003 effective date of the Ikeguchi reference through the filing of the subject application on October 17, 2003.

Attached as Exhibit A to the 131 Declaration is an Invention Disclosure form prepared by Applicant prior to the effective date of the Ikeguchi application (dates have been blocked out pursuant to MPEP 715.07). Exhibit A shows that the inventor conceived the subject matter claimed in the subject patent application prior to August 18, 2003, where support for claims 1-20 can be found in Exhibit A at least on page 4, paragraph 2-3 stating in part:

modify the auto program add feature ... to execute a selective autoprogram add for either the digital terrestrial or the digital cable systems. Furthermore ... the local cable system has a proprietary control system that allows the cable operator to seamlessly move the digital channels about in their cable system while remaining transparent to the user [for] the reassignment of digital cable channels ... select to do an autoprogram add for either digital cable or for digital terrestrial ... The receiver would then execute the appropriate autoprogram channel search. This will reduce the number of actual physical channels and modulation schemes that the TV receiver will have to check during an autoprogram search ... looking for familiar names in the digital streams ... the physical RF channel number is associated with the program, and this is typical amongst the analog terrestrial broadcasts ... identify a digital channel by the name of the channel rather than by the RF channel number ... monitoring the availability of the digital channels, in the

background or even at night, and when a channel disappears, it can use this as a trigger to self-execute a digital cable autoprogram add.

Therefore, the 131 Declaration clearly shows at least some of the facts or data Applicant is relying on to show completion of the invention prior to the August 18, 2003 effective date of the Ikeguchi reference. Additionally, the 131 Declaration factually demonstrates that the Applicant fully explained the invention to outside counsel prior the August 18, 2003 effective date of the Ikeguchi reference so that outside counsel could prepare the subject application.

Therefore, the 131 Declaration demonstrates at least conception in the United States of the invention as claimed with a clear explanation of facts demonstrating support for the pending claims, that the invention was completely disclosed to another through the Invention Disclosure of Exhibit A as well as the teleconference with outside counsel prior to the August 18, 2003 effective date of the Ikeguchi reference, and with a clear demonstration of diligence from at least just prior to the August 18, 2003 effective date of the Ikeguchi reference while the application was being drafted by outside counsel with Applicant's help until the filing of the subject application on October 17, 2003 only two months following the August 18, 2003 effective date.

Further, the 131 Declaration factually demonstrates diligence in the preparation of the subject application at least from just prior to August 18, 2003 until the filing of the subject application in that upon completion of the Invention Disclosure form of Exhibit A, the Invention Disclosure form was submitted to the Intellectual Property Department of Sony Electronic Inc. where it was evaluated and forwarded to outside counsel prior to the effective date of the Ikeguchi reference. The outside counsel prepared the subject patent application with the help of the Applicant, including the Applicant's participation in a conference call with the outside counsel prior to August 18, 2003 where the subject invention was fully described to the outside counsel in detail to allow the outside counsel to prepare the subject application that was filed on October 17, 2003, only two months following the effective date of the Ikeguchi reference during which time the outside counsel was drafting the subject application with the Applicant's assistance.

Still further, the 131 Declaration and Exhibits B-G demonstrate Applicant's diligence in reviewing drafts of the subject application and returning comments to the outside counsel for correction. For example, paragraph 15 and Exhibits B-C factually show that Applicant reviewed portions of the first draft of the application substantially daily and returned comments to the outside counsel, and paragraphs 18 and 20 and Exhibit E again show diligence in that the Applicant reviewed the second draft of the application substantially daily until returning comments to outside counsel. Additionally, paragraphs 24-26 and Exhibits F-G demonstrate that Applicant executed the Declaration within one (1) day of receiving the final draft and formal documents. Therefore, the 131 Declaration factually demonstrates diligence at least on the part of Applicant in constructively reducing the invention to practice.

The Freeland Declaration further factually demonstrates that outside counsel was diligent in preparing the application from at least just prior to the effective date of the Ikeguchi reference until the filing of the application. For example, paragraphs 5 and 6 and Exhibit A factually show that a first draft of the application was forwarded to the Applicant on August 18, 2003; paragraphs 7-11 and Exhibits B-D demonstrate that the outside counsel revised the first draft and working relative to a chronological order relative to other unrelated work the outside counsel returned a second draft to the inventor the day after receiving the inventor's comments; paragraphs 15 and 16 and Exhibits E-F factually demonstrate that the outside counsel revised the second draft working relative to a chronological order relative to other unrelated work and forwarded a final draft with documents for execution to the inventor; and upon receipt of the signed documents prepared and filed the application as shown in paragraphs 18-20 and Exhibit G.

M.P.E.P. section 2136 recites that "[i]f the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient" to establish diligence. As such, the outside counsel diligently and expeditiously worked on preparing the application and filing the application in the chronological order relative to a reasonable backlog of unrelated cases at least from just prior to the effective date of the Ikeguchi reference until the filing of the subject application. Therefore, the Freeland Declaration

factually demonstrates diligence at least on the part of the outside counsel in preparing and filing the subject application.

Based on at least the 131 Declaration and the Freeland Declaration submitted herewith, Applicant has factually demonstrated in clear detail that Applicant conceived of the claimed invention in the United States prior to the effective date of the Ikeguchi reference and that Applicant and outside counsel were diligent in preparing and filing the subject application from at least the time period of just prior to the effective date of the Ikeguchi reference until the filing of the application. Thus, Applicant respectfully requests that the Examiner withdraw the rejection of at least claims 1-3, 7-10, 17-18 and 20 based on the Ikeguchi reference.

Furthermore, at least independent claims 1, 9 and 17 are not anticipated by the Ikeguchi reference. For example, claim 1 recites in part:

- selecting a first input of a plurality of inputs;
- selecting a first single modulation scheme of a plurality modulation schemes on the first input;
- tuning a plurality of channels for the identified single modulation scheme;
- determining if a broadcast is received on each of the channels;
- recording channels that are determined to receive broadcasts in a channel map according to the plurality of tuned channels for the identified single modulation scheme;
- and
- not performing a full auto-program.

The Ikeguchi references fails to teach or suggest at least selecting a first input and selecting a single modulation scheme of a plurality of schemes from the first input as recited in claim 1. The office action suggests that the Ikeguchi reference describes two inputs “Digital tuner 101 and Analog tuner 201” (office action, page 4). Even if you assume *arguendo* that the digital tuner 101 and analog tuner 201 are separate inputs, the Ikeguchi reference fails to teach or suggest the “selecting a first single modulation scheme of a plurality modulation schemes on the first input” as recited in claim 1. Further, the Ikeguchi reference requires a full channel scan because each of the analog scan and the digital scan relies on the other scan to determine whether to evaluate a specific channel and therefore a full channel scan must be performed.

Therefore, Ikeguchi reference fails to teach each limitation as recited in claim 1, and thus, claim 1 is not anticipated by the Ikeguchi reference.

Independent claims 9 and 11 include claim language similar to that of claim 1. Therefore, claims 9 and 11 are also not anticipated by the Ikeguchi reference.

Similarly, claims 2-3 and 7-9, claim 10, and claims 18 and 20 depend from claims 1, 9 and 17, respectively. Therefore, claims 2-3, 7-10, 17-18 and 20 are also not anticipated by the Ikeguchi reference due at least to their dependency on allowable independent claims 1, 9 and 17.

Claim Rejections - 35 U.S.C. § 103

2. Claims 4-6, 11-16 and 19 stand rejected under 35 U.S.C. § 103(a), as being unpatentable over the Ikeguchi reference. Applicant respectfully traverses these rejections in that the 131 Declaration removes Ikeguchi as a reference. Further, the Ikeguchi application fails to teach or suggest at least each element of at least independent claims 1, 9 and 17. Claims 4-6, 11-16 and 19 depend from claims 1, 9 and 17, respectively, and therefore, claims 4-6, 11-16 and 19 are not obvious in view of the Ikeguchi reference due at least to their dependency on allowable claims 1, 9 and 17.

CONCLUSION

Applicant submits that the above remarks demonstrate that the pending claims are in a condition for allowance. Therefore, a Notice of Allowance is respectfully requested.

Respectfully submitted,

Dated: 5-30-06

/smf/

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Attorney for Applicant
(858) 552-1311

Attachments: Declaration of Peter Rae Shintani Pursuant to 37 C.F.R. 1.131 and Exhibits A-G;
and
Declaration of Steven M. Freeland in Support of Declaration of Peter Rae
Shintani Pursuant to 37 C.F.R. 1.131 and Exhibits A-G.

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